Remarks

Applicant thanks the Examiner for the telephone interview of August 25, 2004. In the interview, the Applicant and the Examiner discussed rejections of claims 10, 36 and 43, and the withdrawal of claim 45 made in the Final Office Action. Arguments made the Applicant are summarized within the following remarks.

Withdrawal of Claim 45

The Examiner has withdrawn claim 45 based on the belief that the claim is directed to the nonelected embodiment of Group I. Applicant respectfully disagrees, and respectfully requests that claim 45 be considered in this application.

Applicant has drafted claim 45 to provide an undoubtedly-patentable, generic claim in an effort to expedite prosecution in this patent application. Nowhere in claim 45 is a limitation that the variable upon which an advertisement is selected must be a correlation value such as a similarity value, which is the basis of the definition of Group I. Therefore, claim 45 is not directed to Group I, but rather is generic, and should be examined in this patent application.

Rejection under 35 U.S.C. 102(a) over Culliss

Claims 36-37 and 39-41 were rejected under 35 U.S.C. 102(a) as being anticipated by Culliss (U.S. Patent No. 6,078,916). This rejection is respectfully traversed because the Examiner has erred by not considering all of the claim limitations.

Claim 36 recites targeting an advertisement to a particular numerical range of one or more positions in browsing sequences of Web resources, receiving from a client node a user selection of a hyperlink to a Web resource having a browsing sequence position within the particular numerical range associated with the advertisement, and selecting the advertisement to display with the Web resource based on said targeting and the browsing sequence position of the Web resource.

In contrast, Culliss teaches including advertising banners on a search page of hyperlinks to articles, but does not disclose or suggest targeting a subsequent advertisement, which is displayed with an article after the user selects a hyperlink to the article from the search page, based on the browsing sequence position of the article.

Thus, claim 36 clearly distinguishes over Culliss, and there is no factual basis for the rejection. By depending from claim 36, claims 37 and 39-41 also distinguish over Culliss.

Rejection under 35 U.S.C. 103(a) over Culliss and Cohn et al.

Claims 10-12, 14, 16-25, 27, 29-36 and 39-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Culliss in view of Cohn et al. (U.S. Patent No. 6,308,202). This rejection is respectfully traversed because the Examiner has erred by not considering all of the claim limitations and not interpreting three claim terms based on their conventional definitions.

The rejection of claims 10-12, 24 and 25 is based on the Examiner stating that it would have been obvious to have included advertising with the system of Culliss based on the selected link(s) so as to generate revenue. However, the aforementioned claims do not merely recite advertising with selected link(s), but describe methods that enable a referring Web resource, which has a plurality of user-selectable hyperlinks to a plurality of Web resources, to influence targeting of an advertisement resource to display with a Web resource after a user selects a hyperlink to the Web resource by having at least one script that includes advertiser-usable variables specific to the Web resources. In claim 10, the advertiser-usable variables are read from the script and stored in at least one cookie for the client node before any of the hyperlinks have been selected. In claim 23 (from which claims 24 and 25 depend), the advertiser-usable variables are read from the script by an advertisement server node and stored in a database of the advertisement server node before any of the hyperlinks have

been selected. In either claim, after a hyperlink to a Web resource is selected, the stored advertiser-usable variable specific to the selected Web resource is used by the advertisement server node to target an advertisement to the client node for display with the selected Web resource.

The rejection of claim 23 is further based on the Examiner stating that providing dynamic web page results inherently includes reading of the links, the link information and the link order as it renders a dynamic HTML page of search results. However, as the rejection is presently understood by the Applicant, the Examiner is referring to acts performed by a client node to render a Web page. In contrast, claim 23 describes an advertisement server node reading the advertiser-usable variables from a client node. Further, "reading the link order" (i.e. reading the links in the order that they are presented in an HTML document) to render a dynamic HTML page is not the same as reading advertiser-usable variables.

Still further as a basis to reject claim 23, the Examiner stated that "use of cookies by the ad provider inherently includes at least temporary storage of the cookies in a database/datastore". Applicant disagrees with this statement because cookies are a vehicle for storing and retrieving persistent data at a client node. Unless the Examiner can provide a reference teaching otherwise, Applicant is unaware of databases of ad providers that store cookies per se to perform targeted advertising.

Based on any of the above remarks, Applicant submits

that a prima facie case of obviousness has not been made for independent claims 10 and 23. Independent of the above remarks, further remarks are made with reference to the claims that depend from claims 10 and 23. The further remarks illustrate that even if independent claims 10 and 23 were obvious, prima facie cases of obviousness have not been made for their dependent claims.

The rejection of claims 16 and 29 is based on the Examiner stating that a list of search hits/links is taken to be a tree. However, claims 16 and 29 do not merely recite a tree, but feature tree-defined advertiser-usable variables within at least one script of a referring Web resource to enable the referring Web resource to influence targeting of an advertisement resource to display with a Web resource after a user selects a hyperlink to the Web resource from the referring Web resource. This patentably novel feature is neither disclosed nor suggested by either Culliss or Cohn et al.

The rejection of claims 17 and 30 is based on the Examiner stating that the ordered list of matches to user-submitted search terms provides level numbers of the tree. However, claims 17 and 30 do not merely recite providing a level number of a tree, but feature level-number-indicating advertiser-usable variables within at least one script of a referring Web resource to enable the referring Web resource to influence targeting of an advertisement resource to display with a Web resource after a user selects a hyperlink to the Web resource from the referring Web resource. This

patentably novel feature is neither disclosed nor suggested by either Culliss or Cohn et al.

The rejection of claims 17 and 30 is further based on the Examiner stating that levels can be defined in a variety of ways. Applicant disagrees with this statement. For a particular tree, the level number of a node is specifically defined as the number of edges in the path between the node and a root node (see page 9, lines 4-6).

Still further, the Examiner has not considered all of the claim limitations in the rejection of claims 17 and 30. Including the limitations of its base claim, claim 17 features storing the level numbers of the first and second Web resources in the at least one cookie for the client node before any of the user-selectable hyperlinks have been user selected from the referring Web resource. Including the limitations of its base claim, claim 30 features storing the level numbers of the first and second Web resources in the database of the advertisement server node before any of the user-selectable hyperlinks have been user selected from the referring Web resource. These patentably novel features are neither disclosed nor suggested by either Culliss or Cohn et al.

The rejection of claims 18-22 and 31-35 is based on the Examiner stating that "any of the links appearing within the tree/list of results can be taken to be 'internal' to the list/tree", "the links on the list/tree can be taken as 'leaves' on the tree", and "the list can be simply taken to be leaves in a list". The Examiner's definitions of

"internal" and "leaf" are inconsistent with their conventional definitions.

Applicant presented a review of trees and graph-related terminology on page 8, line 3 to page 9, line 11 of the present application. In particular, starting on page 9, line 1, a leaf node is conventionally defined as a node with no children, and an internal node is conventionally defined as a node with at least one child.

Thus, the Examiner's statement that "any of the links appearing within the tree/list of results can be taken to be 'internal' to the list/tree" is nonsensical because every tree or list has at least one node that is not internal thereto (i.e. every tree or list has at least one leaf node). Further, the Examiner's statements that "the links on the list/tree can be taken as 'leaves' on the tree" and "the list can be simply taken to be leaves in a list" are nonsensical because a list unto itself can have only one leaf node, in particular the final element of the list.

The Examiner stated that claims 21 and 22 are met by Culliss providing a first link having links below it as well as a second link having links below it in a search results list/tree. Applicant disagrees with this statement. Claims 21 and 34 describe specific advertiser-usable variables, each being based on the ancestry of its corresponding Web resource in the tree. More specifically, the particular ancestor on which the advertiser-usable variable is based is the ancestor at a predetermined level number in the tree. Thus, including the limitations in their base claims, claims

21 and 34 feature the first advertisement being targeted for display with the first Web resource based on another Web resource, namely which ancestor of the first Web resource has a particular level number in the tree. This patentably novel feature is neither disclosed nor suggested by either Culliss or Cohn et al.

The rejection of claims 14 and 27 is based on the Examiner stating that it would have been obvious to have satisfied the advertising requests by reading the cookies to determine URLs. However, the additional limitations in claims 14 and 27 do not pertain to reading the cookies, but rather pertain to reading the advertiser-usable variables within the at least one script of the referring Web resource in response to an advertising request associated with the referring Web resource. The acts of receiving the advertising request and reading the variables in claim 14 are performed before the variables have been stored in the cookie(s).

The rejection of claims 36 and 39-41 is based on the Examiner stating that ads targeted to ordered URLs are taken to be targeted to the ordered positioning within the list. Applicant disagrees with this interpretation. Cohn et al. discloses targeting an ad to a category of content, and transmitting the ad if content from a URL is within the category. Thus, regardless of the ordering of the URLs in Culliss, Cohn et al. would provide the same content-based advertising for each URL based on each URL's content. Further, if the two targeting criteria were equivalent,

either Culliss or Cohn et al. would disclose or suggest that changing an ordered position of a particular URL may cause a different ad to be selected for display with content from the particular URL. Applicant sees no such teaching or suggestion in Culliss or Cohn et al.

The rejection of claims 36 and 39-41 is further based on the Examiner stating that Culliss teaches that the system scoring is based upon the relative positioning of the links within the list/tree. However, this aspect of Culliss is irrelevant to claims 36 and 39-41.

Based on any of the above remarks, Applicant submits that a prima facie case of obviousness has not been made for independent claim 36. Independent of the above remarks, further remarks are made with reference to claims 40 and 41. The further remarks illustrate that even if independent claim 36 were obvious, claims 40 and 41 are non-obvious.

The rejection of claims 40 and 41 is further based on the Examiner stating that "any of the positions represent URLs which can be used as a basis for targeted ads" (emphasis added). However, the Examiner is using knowledge gleaned only from the Applicant's disclosure, and not from Culliss or Cohn et al. or knowledge which was within the level of ordinary skill at the time the claimed invention was filed, to state what "can be" done. Therefore, the Examiner is using impermissible hindsight in formulating the rejection of claims 40 and 41.

Based on the above arguments, Applicant submits that claims 10-12, 14, 16-25, 27, 29-36 and 39-41 are patentable

over Culliss in view of Cohn et al.

Rejection under 35 U.S.C. 103(a) over Culliss in view of Cohn et al. and Merriman et al.

Claims 13 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Culliss in view of Cohn et al. and Merriman et al. (U.S. Patent No. 5,948,061). This rejection is respectfully traversed.

Claims 13 and 26 are submitted to be patentable over Culliss in view of Cohn et al. and Merriman et al. by depending indirectly from base claims 10 and 23, respectively, which are submitted to be patentable over Culliss in view of Cohn et al., and because Merriman et al. neither discloses nor suggests the patentable subject matter of claims 10 and 23.

Thus, regarding claim 13, neither Culliss, Cohn et al., nor Merriman et al. discloses or suggests the patentably novel feature of a referring Web resource, which has a plurality of user-selectable hyperlinks to a plurality of Web resources, influencing targeting of an advertisement resource to display with a Web resource after a user selects a hyperlink to the Web resource by having at least one script that includes advertiser-usable variables specific to the Web resources, which advertiser-usable variables are read from the script and stored in at least one cookie for the client node before any of the hyperlinks have been selected.

Regarding claim 26, neither Culliss, Cohn et al., nor

Merriman et al. discloses or suggests the patentably novel feature of a referring Web resource, which has a plurality of user-selectable hyperlinks to a plurality of Web resources, influencing targeting of an advertisement resource to display with a Web resource after a user selects a hyperlink to the Web resource by having at least one script that includes advertiser-usable variables specific to the Web resources, which advertiser-usable variables are read from the script by an advertisement server node and stored in a database of the advertisement server node before any of the hyperlinks have been selected.

Rejection under 35 U.S.C. 103(a) over Culliss in view of Cohn et al. and Davis et al.

Claim 37 was rejected under 35 U.S.C. 103(a) as being unpatentable over Culliss in view of Cohn et al. and Davis et al. (U.S. Patent No. 6,269,361). This rejection is respectfully traversed.

The basis of the rejection of claim 37 is the Examiner stating that it would have been obvious to include a component of advertisers paying to affect the placement/order of search results with the scoring and ordering of Culliss' search results, where advertisers pay more for higher listings as taught by Davis et al. However, the Examiner's combination relates to advertising on a page of search results, whereas claim 37 relates to billing rates charged for advertising presented to a user after the user has selected a hyperlink in a browsing sequence. In the

context of the Examiner's combination, the billing rate in claim 37 is for an advertisement displayed with an article after the user has clicked on a hyperlink to the article from the search results page.

Since the Examiner has erred in which page is displaying the advertisement, Applicant submits that a case of obviousness has not been made for claim 37. Further, since claim 37 has a patentably novel feature of charging a higher billing rate for advertising presented to a user after the user has selected a hyperlink based on the hyperlink having a lower level number in a browsing sequence, Applicant submits that claim 37 is patentable over Culliss in view of Cohn et al. and Davis et al.

Rejection under 35 U.S.C. 103(a) over Culliss in view of Cohn et al. and www.cookiecentral.com

Claims 42-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Culliss in view of Cohn et al. and www.cookiecentral.com. This rejection is respectfully traversed.

In the rejection of claims 43-44, the Examiner has erred by: not considering the limitations of the at least one cookie in independent claim 10 together with the additional limitations of the same at least one cookie in dependent claims 43 and 44; making statements which contradict statements made in the rejection of independent claim 10; proposing a modification that would render the primary reference (Culliss) unsatisfactory for its intended

purpose; and basing the rejection on a motivation to modify Culliss that is contrary to the invention in independent claim 10.

The Examiner's basis of rejecting independent claim 10 is that the at least one cookie of claim 10 is met by the disclosure in Culliss of a search engine which stores search activity data in cookies so that the search engine can retrieve the data to affect future search result scores. In the rejection of dependent claims 42-44, the Examiner has taken Official Notice that cookies set by a particular domain can only be read by servers from that domain. Since the search engine in Culliss is setting the cookies, the Examiner's Official Notice implies that the cookies in Culliss can only be read by the search engine. However, the Examiner contradicts this implication in the rejection of claims 42-44 by stating that it would be obvious to make those same cookies unreadable by the search engine. Thus, the Examiner's statements in rejecting the base claim and its dependent claims are contradictory by implying that cookies that can only be read by the search engine are unreadable by the search engine.

Further, if the cookies were unreadable by the search engine of Culliss, the search engine of Culliss would not be operative to retrieve the data to affect future search result scores. Thus, the modification of Culliss proposed by the Examiner would render Culliss unsatisfactory for its intended purpose of the search engine affecting future search result scores by storing search activity data in

cookies so that the search engine can retrieve the cookies.

Still further, the motivation provided by the Examiner to modify Culliss "so that the search engine entity can focus its efforts on its core business of providing search results and outsource its advertising services to such a third party" highlights a fundamental misunderstanding by the Examiner in considering these and other claims in the present application. If the search engine entity were to provide the referring Web resource of independent claim 10, the search engine entity would focus on both providing search results and influencing which advertisement is targeted for display after a user clicks on a search result link by setting the values of the advertiser usable-variables within the at least one script.

Conclusion

Applicant believes the present application is in a condition for allowance. The Examiner is invited to call the Applicant at the telephone number below for any reason to advance the prosecution of this application.

Respectfully submitted,

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